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EXAMINER
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ROBINSON, KITO R

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/506,739	<b>Applicant(s)</b> ONG, YONG KIN (MICHAEL)	
	<b>Examiner</b> KITO R. ROBINSON	<b>Art Unit</b> 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-14,16-45,47-52,72-77 and 79-92 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-14,16-45,47-52,72-77 and 79-92 is/are rejected.
- 7) ☒ Claim(s) 87-92 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/30/2010</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the amendment filed on 17 September 2010.
2. Claims 2, 15, 46, 53-71 & 78 have been canceled.
3. Claims 87-92 have been added.
4. Claims 7 & 86 have been amended.
5. Claims 1, 3-14, 16-45, 47-52, 72-77 and 79-92 are currently pending and have been examined.

### **Information Disclosure Statement**

6. The Information Disclosure Statements filed on 18 October 2004, 14 December 2004, 02 March 2009, 02 April 2010 & 30 September 2010 have been considered. An initialed copy of the Form 1449 is enclosed herewith.

### **Priority**

7. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### **Claim Objections**

8. Claims 87-92 are objected to because of the following informalities: Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of

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every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered). Claims 87-92 are not properly labeled. Appropriate correction is required.

### **Response to Arguments**

9. Applicant's arguments received on 17 September 2010 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.
10. With regard to the limitations of claim 1, 48, 49 & 50, Applicant argues "It is respectfully submitted that Ice does not contain a disclosure of the all of the features said to be present by the examiner. It is apparent that the examiner has equated the single use transaction request identification (of the claim) with the single use credit card number (of the reference). The transaction manager (of the claim) seems to have been equated to the payment server (of the reference). Because the single use credit card number has been equated to the single use transaction request identification it can not also be the received user identifier (of the claim). While the address may be regarded as a user identifier, it is not received by the payment server (or the gateway server) in a payment request as required by claim 1 (and is therefore not the "received user identifier" referred to in the claim)."

The Examiner respectfully disagrees. First, the Examiner acknowledges the inadvertent missing of claims 48 & 49 in the heading and has added the missing claims to the heading. In reference to claims 1, 48, 49 & 50 the Ice reference disclose two processes generating the single use credit card number and

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the approval of the transaction. "When the user of the computer terminal 10 alternately wishes to purchase a product or service over the public network 12 using a debit card 32, he swipes the debit card 32 through the slot 30 in the encryption unit 26" (column 4, lines 54-58). "At this point, **the data transferred from the personal computer 14 the payment server 34 includes both encrypted information identifying the credit card number and unencrypted information specifying the serial number of the encryption unit 26 and the address to which the transaction is to be billed**" (column 4, lines 25-30). "**The payment server 34 then generates a single-use credit card number**, which is stored in a data structure 50 within the database 36, **along with the data received from the personal computer 14**" (column 4, lines 54-57). "The single-use credit card number is also returned to the personal computer 14 over the public network 12" (column 4, lines 60-62). "After the personal computer 14 receives the single-use credit card number, this number is placed in window of the browser program executing within the personal computer 14 where the credit card number would otherwise be placed. While the single-use credit card number 52 is preferably handled within the personal computer 14 by software executing in the processor 20, the new number may alternately be displayed for the user to type as part of his order. Next, the order is transferred over the public network 12 to a web site server 54 operated by the merchant from which the goods or service is being ordered. The order is placed using the single-use credit card number 52 received from the payment server 34, along with other data identifying the object to be purchased, etc., by transmission over the public network 12 between the personal computer 14 and the merchant's web site server 54" (column 5, lines 1-15).

It is clear that the single use transaction request identification (of the claim) is equated with the single use credit card number (of the reference). The transaction manager (of the claim) is equated with the payment server. The user identifier (of the claim) is equated with the address to which the transaction is to be billed and serial number (of the reference). In column 5, lines 46-50, the payment server by way of the gateway server, receives the single use credit card number (single use transaction request identification of the claim) to compare. The payment server already received the a user identifier (address) and value (inherent) from the initial start of the transaction from the personal computer. Therefore, Applicant's arguments are not persuasive.

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Applicant further argues "The gateway server of Ice does not: "(determine) the validity of the received payment request by checking the validity of the received transaction request identification and whether the received transaction request identification is stored in a relationship with the received user identification ". Instead the payment server checks the validity of the single use single use credit card number and whether the received transaction request identification is stored in a relationship with the serial number and in turn with the decrypted credit card number and address, (neither of which were received in the payment request)."

The Examiner respectfully disagrees. In column 5, lines 50-56 discloses "Next, the payment server 34 compares the single-use credit card number 52 with data stored within its database 36 in data structure 50. When a match is found, the payment server reads the serial number associated with the single-use credit card number in the data structure 50, and searches the data structure 48 for this serial number. When this serial number is found in the data structure 48, the payment server 34 uses the cryptogram associated with the serial number in the data structure 48 to decode the encrypted data associated with the single-use credit card number in the data structure." The validity of the payment request is checked by the payment server which matches the single use credit card number with the stored number and serial number then decodes the data structure which contains the additional information provided by the personal computer (actual credit card number, serial number and billing address). Therefore, Applicant's arguments are not persuasive.

Applicant further argues, "It is the gateway server that proceeds with a conventional credit card transaction (after the payment server has substituted the single-use credit card number with the actual credit card number) and not the payment server. Therefore, it is the gateway server and not the payment server that: "(receives) at the transaction manager apparatus (the payment server) confirmation of the transfer from the financial institution when the transfer is performed."

The Examiner respectfully disagrees. In column 7, lines 20-24 disclose "Upon approval of the debit card transaction, the bank computer 64 returns an approval indication to the payment server 33. The payment server 33 then returns an approval indication to the gateway server 58, which in turn notifies the merchant's web site server 54." Therefore, applicant's arguments are not persuasive.

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11. With regard to the limitations of claim 14 Applicant argues "With regard to claim 14, this requires the payment request to further comprise a component provided by the registered user and the transaction manager apparatus receives the user provided component from the user independently from and before receiving the purchase request, and storing of the user provided component in the storage in a relationship with the identifier of the registered user. This is not disclosed in Ice despite the assertion that it is disclosed by the user swiping the card, because the user provided component is not provided in the payment request. Only the single use credit card number (the value and merchant ID) are provided in payment request."

The Examiner respectfully disagrees for the same reason stated above. During the initial card reading the user provides the user components first, its not until after the actual card number is replaced with the single use number which is then provided to the payment server by way of the gateway server is the payment request completed.

12. With regard to the limitations of claim 16 Applicant argues "With regard to claim 16, this requires comparing the user provided component received in the payment request with the stored user provided component to determine the validity of the payment request. Since the payment request does not include the user provided component this comparison can not occur."

The Examiner respectfully disagrees for the same reason stated above. The validity of the payment request is checked by the payment server which matches the single use credit card number with the stored number and serial number then decodes the data structure which contains the additional information provided by the personal computer (actual credit card number, serial number and billing address).

13. With regard to the limitations of claim 17 & 28 Applicant argues "Claim 17 requires the user provided component comprise a secret identification of the user known to the registered user. Ice discloses providing a PIN to the payment server, but this is a precursor step and not part of a payment request and Claim 28 requires a user provided component that comprises a secret identification of the user known to the registered user and recorded in the financial institution. Again while providing a PIN to

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the payment server is disclosed as a precursor step, there is no disclosure of the PIN being provided in a payment request.”

The Examiner respectfully disagrees for the same reason stated above. The user provides a PIN.

14. With regard to the limitations of claim 18 Applicant argues “Claim 18 requires a transaction limit and with a transaction limit override password. While Robinson may describe a transaction limit, there is no disclosure of a transaction limit override password.

The Examiner respectfully disagrees. Further details of the override function is disclosed in the incorporated reference (09/765,789) which disclose in paragraph 0058 real time authorization by the primary account holder of transactions that exceed a predetermined threshold. The primary card hold must request approval of the transaction via a communication device before the transaction can be approved.

15. With regard to the limitations of claim 26 Applicant argues “Claim 26 requires combining the transaction request identification and the user provided component by hatching, Ice makes no disclosure of hatching.”

The Examiner respectfully disagrees. Column 4, lines 7-11 do not explicitly say hatching however the unencrypted number is combined with the PIN to create a 64 character string which is synonymous with the definition of hatching as applicant disclosed in claim 26.

### **Claim Rejections - 35 USC § 103**

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:



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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18. Claims 1-4, 6-12, 14, 16-32, 34-37, 43-45, 47-52, 72-77, 79-82, 84-90 & 92 are rejected under 35

U.S.C. 103(a) as being unpatentable over Ice US Patent Number 6,598,031 B1 in view of Robinson

US 2003/0061172 A1.

**As per claim 1, 48, 49 & 50**

Ice discloses:

- *generating a single use transaction request identification with a transaction manager (column 4, lines 54-57)*
- *storing the generated single use transaction request identification in a relationship with an identifier of a registered user and banking information of the registered user in a storage of the transaction manager apparatus; (column 4, lines 54-57)*
- *sending the generated single use transaction request identification to the registered user from the transaction manager (column 4, lines 60-63);*
- *receiving at the transaction manager apparatus a payment request comprising a received user identifier, a value and information for making a fund transfer of the value from the registered user identified by the received user identifier to an identified recipient, the payment request also including a received transaction request identification; (column 5, lines 43-53 & column 5, lines 61-64)* Ice does not explicit state a value but it is inherent in the teaching that the transaction cannot be approved without a value;
- *determining the validity of the received payment request by checking the validity of the received transaction request identification and whether the received transaction request identification is stored in a relationship with the received user identifier with the transaction manager apparatus; (column 5, lines 43-56);*
- *disabling re-use of the single use transaction request identification (Column 6, lines 5-9)*

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- *sending an EFT request to a financial institution system to transfer the value in funds from the registered user to the recipient, only if the received payment request is valid, the EFT request including the banking information, (column 5, lines 61-65);*
- *receiving at the transaction manager apparatus confirmation of the transfer from the financial institution when the transfer is performed (column 5, lines 61-65)*
- *sending a confirmation message from the transaction manager apparatus to one or more of the group consisting of the user and the recipient (column 5, lines 61-65).*

Ice does not disclose the following, however Robinson does:

- *a registered user (**Abstract**)*
- *such that the financial institution is able to check whether sufficient funds are present in a user's financial institution account and, in the event that sufficient funds are present the financial institution is able to perform the transfer according to the EFT request (**paragraph 0074**);*

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice with the technique of Robinson because it is a quick, easy and convenient way to register and verify the user's and merchant's identity to the system.

#### **As per claim 3, 51 & 52**

Ice discloses:

- *the transaction request identification is a random number (**paragraph 0040**).*

#### **As per claim 4**

Ice discloses:

- *the transaction request identification is generated using a formula (**paragraph 0025**).*

#### **As per claim 6**

Ice discloses:

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- *the payment request comprises a component provided by the registered user (Column 1, lines 2-3).*

**As per claim 7**

Ice discloses:

- *the recipient is provided with a further combination of the transaction request identification and the user provided component (column 5, lines 61-65).*

**As per claim 8**

Ice discloses:

- *the banking information related to the transaction request identification includes a credit card or debit card number, a card expiry date and a cardholder name (column 1, lines 43-46).*

**As per claim 9**

Ice discloses:

- *the banking information includes a bank account number (column 5, lines 21-24).*

**As per claim 10**

Ice discloses:

- *the banking information includes bank account type and bank account holder information (paragraph 0036: Ice does not explicitly disclose bank account type however it is inherent that if the verification system checks the validity of the credit card indicating whether the type of bank account is valid).*

**As per claim 11**

Ice discloses the limitations as shown in the rejection of Claim 1 above. Ice does not disclose the limitation of *registering an unregistered user prior to the generation of the transaction request*

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*identification*. However, Robinson, in the Abstract discloses “System users register at least one biometric identifier, personal and/or business identity -verifying data, and financial account information.”

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice with the technique of Robinson because it is a quick and easy way to verify the user.

#### **As per claim 12**

Ice discloses the limitations as shown in the rejection of Claim 1 above. Ice does not disclose the limitation of *registration of the user comprises creating of a transaction manager user account, and the identifier of the registered user is a transaction manager account number allocated by the transaction account manager*. However, Robinson, in paragraph 0036 discloses “one or more financial account (e.g. checking, credit, or value); and a consumer may choose a SID from any of the previously listed numbers, may create a SID, provided the SID is unique to the central database 102, or may choose from system suggested ID numbers.”

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice with the technique of Robinson because it is a quick and easy way to set up a user account and verify the user.

#### **As per claim 14**

Ice discloses:

- *the transaction manager apparatus receiving the user provided component from the user independently from and before receiving the purchase request and storing the user provided component in the storage in a relationship with the identifier of the registered user (column 3, lines 66-67, column 4, lines 16-20, column 4, lines 50-53, column 4, lines 54-57 & column 4, lines 60-62)*. The user swiping the card provides the first 16 digits before receiving and storing the purchase request and the generation of the single use number.

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**As per claim 16**

Ice discloses:

- *wherein determining the validity of the received payment request further comprises comparing the user provided component received in the payment request with the stored user provided component and determining that the payment request is invalid when the user provided component is not the same as or based on the stored user provide component (column 5, lines 47-53)*

**As per claim 17**

Ice discloses:

- *the user provided component comprises a secrete identification of the user known to the registered user (column 3, lines 66-67, column 4, lines 7-11)*

**As per claim 18**

Ice discloses the limitations as shown in the rejection of Claim 1 above. Ice does not disclose the limitation of *storing the transaction request identification in association with a transaction limit, and with a transaction limit override password wherein the transaction manager apparatus does not send the EFT request if the value is above the transaction limit and the transaction limit override password is not received in the payment request*. However, Robinson, in paragraph 0087 discloses "Such pre-set parameters may include but are not limited to consumers setting a limit on how much may be spent out of a specific account."

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice with the technique of Robinson because it is a quick and easy way to provide added security to the user.

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**As per claim 19**

Ice discloses:

- *sending the registered user another single use transaction request identification from the transaction manager apparatus upon receipt at the transaction manager apparatus of a request by the registered user (column 6, lines 5-9)*

**As per claim 20-22**

Ice discloses the limitations as shown in the rejection of Claim 1 above. Ice does not disclose the limitation of *the registering a merchant with the transaction manager apparatus as one of a number of possible recipients, registration of the merchant comprises the transaction manager apparatus providing the merchant with a merchant identification and the transaction manager apparatus storing merchant banking information in a relationship with the merchant identification, wherein the purchase request received by the transaction manager apparatus includes the merchant identification*. However, Robinson, in at least Paragraph 0037 discloses “Merchant accounts comprise information useful for authenticating a merchant, associating a merchant with a financial account, and completing transactions. By way of illustration and not as a limitation, a merchant account may comprise a SID, merchant location, and a phone number; a list of terminal ID numbers (TIDs) of the terminals designated to perform system functions; one or more financial accounts; and enrollment and transaction approval/decline parameters.”

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice with the technique of Robinson because it is a quick, easy and convenient way to register and verify the merchant identity to the system.

**As per claim 23**

Ice discloses:

- *the registered user requesting purchase of a product or service having the value from the merchant and the merchant providing the payment request to the transaction manager apparatus*

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**(column 5, lines 43-53 & column 5, lines 61-64)** Ice does not explicit state a value but it is inherent in the teaching that the transaction cannot be approved without a value;

**As per claim 24**

Ice discloses:

- *the registered user nominating an item for purchase and a merchant device of the recipient constructing the purchase request including determining the value in the purchase request based on the nominated item (column 5, lines 12-16).* Ice does not explicit state a value but it is inherent in the teaching that the transaction cannot be approved without a value.

**As per claim 25**

Ice discloses:

- *checking the validity of the received transaction request identification in the payment request comprises checking whether the transaction request identification received in the payment request is the same as or derived from the stored transaction request identifier stored in the relationship with the user identifier (column 5, lines 43-56);*

**As per claim 26**

Ice discloses:

- *combining the transaction request identification and the user provided component by hatching the transaction request identification and the user provided identification component (column 4, lines 7-11).*

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**As per claim 27**

Ice discloses:

- *disabling of the use of the transaction request identification is comprises removing the relationship between the transaction request identification and the user's transaction manager account number (column 6, lines 33-42)*

**As per claim 28**

Ice discloses:

- *user provided component comprises a secrete identification of the user known to the registered user and recorded in the financial institution (column 4, lines 7-11: Pin).*

**As per claim 29**

Ice discloses:

- *disabling use of the transaction request identification includes the step of adding the transaction request identification to a spent list, the spent list being used to ensure a transaction request identification is not reused (column 6, lines 5-9);*

**As per claim 30**

Ice discloses:

- *the EFT request sent to the financial institution comprises the user's banking information the value and merchant account banking information and sent to the financial institution system to transfer the funds according to a standard electronic fund transfer process (column 5, lines 61-67 & column 6, lines 1-4).*



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**As per claim 31**

Ice discloses the limitations as shown in the rejection of Claim 1 above. Ice does not disclose the limitation of *the financial institution sending an insufficient funds reply if sufficient funds are not present, whereupon the transaction manager apparatus sends an insufficient funds reply to the recipient.* However, Robinson, in at least Paragraph 0074 discloses "In yet another embodiment, the central database communicates with other financial databases to obtain financial information about the consumer relevant to determining whether or not the consumer has sufficient funds to cover the transaction." Paragraph 0075 discloses "If the transaction is declined, notice is sent to the local device 620, along with a reason the transaction was declined."

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice with the technique of Robinson because it is a quick, easy and convenient way to check for sufficient funds in the users account.

**As per claim 32**

Ice discloses:

- *the confirmation message sent from the transaction manager apparatus to the recipient is the same as the confirmation of the transfer received from the financial institution (column 5, lines 61-65)*

**As per claim 34**

Ice discloses:

- *disabling re-use of the transaction request identification includes the formula for generating the single use transaction request identification including an increment in the next generated transaction identification request (column 6, lines 5-9)*

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**As per claim 35**

Ice discloses:

- *the method of generating the transaction identification includes providing a check sum digit or character in the transaction request identification (column 4, lines 67)*

**As per claim 36**

Ice discloses:

- *the transaction request identification is a number (column 4, lines 5-7).*

**As per claim 37**

Ice discloses:

- *sending a confirmation of the transfer of funds from the transaction manager apparatus to the registered user (column 7, lines 20-24)*

**As per claim 43**

Ice discloses:

- *sending the transaction request identification to the portable storage device comprises sending a plurality of transaction request identifications to the portable storage device and storing the identifications in the portable storage device (column 2, lines 24-33)*

**As per claim 44**

Ice discloses:

- *sending a plurality of transaction request identifications may be provided to the user (claim 27)*

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**As per claim 45**

Ice discloses the limitations as shown in the rejection of Claim 1 above. Ice does not disclose the limitation of *the transaction manager apparatus managing a plurality of registered users each having a plurality of transaction request identifications available for use in making a purchase*. However, Robinson, in at least Paragraph 0012 discloses “The system of the invention comprises registration of a plurality of merchants, employees, and consumers so that these parties may conduct enrollment, transaction, and account access functions within the system.”

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice with the technique of Robinson because it is a quick, easy and convenient way to register and verify the merchant's and user's identity to the system.

**As per claim 47**

Ice discloses:

- *selecting the financial institution from a plurality of financial institutions according to the bank information retrieved according to the payment request after the payment request is validated (column 5, lines 61-65).*

**As per claim 72**

Ice discloses:

- *recording a user identifier for each of at least one user registration in the transaction manager apparatus (column 4, lines 16-20 & column 2, lines 24-28).*

**As per claim 73**

Ice discloses:

- *the payment request comprises recipient identifier indicative of recipient account for receipt for the funds transfer (column 5, lines 61-67 & column 6, lines 1).*

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**As per claim 74**

Ice discloses:

- *retrieving the stored transaction request identification from within the storage of the transaction manager apparatus based on the received user identifier for determination whether the received transaction request identification is stored in a relationship with the received user identifier (column 5, lines 50-57).*

**As per claim 75**

Ice discloses:

- *identifying the registered user when a remotely located electronic device of the registered user connects to the transaction manager apparatus (column 2, lines 17-23).*

**As per claim 76**

Ice discloses:

- *generation of the single use transaction request identification occurs when the registered user is identified (column 4, lines 25-30 & column 4, lines 54-57).*

**As per claim 77**

Ice discloses:

- *terminating the transaction when the received transaction request identifier is not validated (column 5, lines 50-53). It is inherent in Ice that if I match is not found then the decoded data is not returned to the gateway server.*

**As per claim 79**

Ice discloses:

- *the confirmation message is sent from the transaction manager apparatus to a merchant electronic device of the recipient (column 5, 65-67 & column 6, lines 1).*

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**As per claim 80**

Ice discloses:

- *the registered user causes the transaction request identification to be sent from a user electronic device to the merchant electronic device (column 5, lines 1-11).*

**As per claim 81**

Ice discloses:

- *the merchant electronic device sends the payment request to the transaction manager apparatus (column 5, lines 12-16).*

**As per claim 82**

Ice discloses the limitations as shown in the rejection of Claim 1 above. Ice does not disclose the limitation of *receiving an insufficient funds message from the financial institution computer system if sufficient funds are not present to conduct the transactional interaction, whereupon the transaction manager apparatus sends an insufficient funds message to the recipient.* However, Robinson, in at least Paragraph 0074 discloses "In yet another embodiment, the central database communicates with other financial databases to obtain financial information about the consumer relevant to determining whether or not the consumer has sufficient funds to cover the transaction." Paragraph 0075 discloses "If the transaction is declined, notice is sent to the local device 620, along with a reason the transaction was declined."

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice with the technique of Robinson because it is a quick, easy and convenient way to check for sufficient funds in the users account.

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**As per claim 84**

Ice discloses the limitations as shown in the rejection of Claim 1 above. Ice does not disclose the limitation of *inputting registration information of a prior registered user in to the transaction manager apparatus, the registration information including the banking information*. However, Robinson, in Abstract discloses "System users register at least one biometric identifier, personal and/or business identity-verifying data, and financial account information."

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice with the technique of Robinson because it is a quick, easy and convenient way to link the accounts with the registered user.

**As per claim 85 & 86**

Ice discloses:

- *identifying a registered user when a remotely located electronic device of the registered user connects to the transaction manager apparatus (column 2, lines 17-23);*
- *generating a single use transaction request identification with a transaction manager (column 4, lines 54-57)*
- *receiving at the transaction manager apparatus a secret code known to and provided by the identified registered user (column 4, lines 7-11: Pin);*
- *storing in the transaction manager apparatus the generated single use transaction request identification in association with the user identifier of the identified registered user, the secret code and banking information of the identified registered user for use by a financial institution computer system in association with the user identifier; (column 4, lines 54-57)*
- *sending the generated single use transaction request identification to the registered user from the transaction manager (column 4, lines 60-63);*
- *receiving at the transaction manager apparatus a payment request comprising a request identifier, a user identifier, a recipient identifier, a value and a test code; (column 5, lines 43-53)*

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**& column 5, lines 61-64)** Ice does not explicit state a value but it is inherent in the teaching that the transaction cannot be approved without a value;

- *retrieving the stored transaction request identification and the secret code from within the transaction manager apparatus based on the received user identifier (column 6, lines 33-37) ;*
- *determining the validity of the received request identifier by the transaction manager apparatus checking whether the received request identifier is the same as or based on the retrieved transaction request identification and whether the test code is the same as or based on the secret code, and disabling re-use of the single use transaction request identification when the received request identifier is validated, and terminating the transactional interaction when the received request identifier is not validated; (column 5, lines 43-56 & Column 6, lines 5-9);*
- *retrieving the stored banking information of the registered user in the stored data relationship with the received user identifier (column 5, lines 50-57);*
- *sending an EFT request to a financial institution system to transfer the value in funds from the registered user to the recipient, only if the received payment request is valid, the EFT request including the banking information, (column 5, lines 61-65);*
- *receiving at the transaction manager apparatus a first confirmation message from the financial institution computer system when the transactional interaction has been successfully completed according to the EFT request message; and (column 5, lines 61-65)*
- *sending a second confirmation message from the transaction manager apparatus to a second electronic device when the first confirmation message is received (column 5, lines 61-65).*

Ice does not disclose the following, however Robinson does:

- *recording a user identifier for each of a plurality of user's at least one user registration in a transaction manager apparatus (Abstract);*
- *a registered user (Abstract)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice with the technique of Robinson because it is a quick, easy and convenient way to register and verify the user's and merchant's identity to the system.

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**As per claim 87**

Ice discloses:

- *wherein the payment request is constructed from the user identifier and transaction request identifier received from the user (column 4, lines 25-30).*

**As per claim 88**

Ice discloses:

- *the payment request is also constructed from a user provided secret component sent to the merchant device (column 4, lines 7-11: Pin).*

**As per claim 89**

Ice discloses:

- *wherein the other account is a financial institution account also held by the registered user (column 3, lines 60-65).*

**As per claim 90**

Ice discloses:

- *wherein the EFT request comprises destination bank account information selected from the stored banking information according to the identifier of the other account (column 3, lines 60-65).*

**As per claim 92**

Ice discloses:

- *wherein the EFT request comprises destination bank account information which is selected from stored banking information of a plurality of recipients according to a recipient identifier in the*



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*payment request after the payment request is validated (column 5, line 50-53 & column 5, lines 57-60).*

19. Claims 3-5, 33, 38-42, 83 & 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ice in view of Robinson and in further view of **Official Notice**.

**As per claim 3 & 4**

With regard to the limitation of *the transaction request identification is generated using a random number or a formula*, Ice in column 4, lines 63-67 discloses FIG. 2 is a pictographic view of the 16-digit single-use credit card number 52. The first six digits are an ISO BIN number identifying the payment server 34. The following nine-digits are a transaction number assigned by the payment server 34. The final digit is a checksum digit. Ice does not specifically state *a random number or a formula*. However, the Examiner takes **Official Notice** that it is old and well known in the banking arts to generate transaction numbers by formula or a random number generator.

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice & Robinson with the technique of **Official Notice** because it is a quick, easy and convenient way to generate transaction numbers that are not repeated which reduces the chances of fraud from predicting the transaction numbers.

**As per claim 5**

With regard to the limitation of *the transaction request identification is generated using a random number and a formula*, Ice in column 4, lines 63-67 discloses FIG. 2 is a pictographic view of the 16-digit single-use credit card number 52. The first six digits are an ISO BIN number identifying the payment server 34. The following nine-digits are a transaction number assigned by the payment server 34. The final digit is a checksum digit. Ice does not specifically state *a random number and a formula*. However, the Examiner takes **Official Notice** that it is old and well known in the banking arts to generate transaction numbers by formula and a random number generator.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice & Robinson with the technique of **Official Notice** because it is a quick, easy and convenient way to generate transaction numbers that are not repeated which reduces the chances of fraud from predicting the transaction numbers.

### **As per claim 33**

With regard to the limitation of *confirmation message sent from the transaction manager to the merchant is created by the transaction manager apparatus and is different to the confirmation of the transfer received from the financial institution*; Robinson, in at least Paragraph 0074 discloses "In yet another embodiment, the central database communicates with other financial databases to obtain financial information about the consumer relevant to determining whether or not the consumer has sufficient funds to cover the transaction." Paragraph 0075 discloses "If the transaction is declined, notice is sent to the local device 620, along with a reason the transaction was declined." However, the Examiner takes **Official Notice** that it is old and well known in the banking arts to provide a different confirmation message to the merchant.

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice & Robinson with the technique of **Official Notice** because it is an easy and convenient way to notify the transaction has been completed.

### **As per claim 38-40**

With regard to the limitation of *the confirmation sent to the registered user is an e-mail message, the transaction request identification is to the registered user via the Internet and the transaction request identification is sent to the registered user by a telephone interface system*; Robinson in paragraph 0045 discloses "Parties interested in enrolling in the invention's system further have the option to pre-enroll, that is provide a partial enrollment, by providing only a portion of the required enrollment information, for the invention's services via a computer 104, a kiosk 128, or a wireless device 122, which is connected to a network, preferably but without limitation the Internet, which is connected to the invention's central

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database 102.” However, the Examiner takes **Official Notice** that it is old and well known in the banking arts to provide a confirmation messages through email, the internet or the phone.

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice & Robinson with the technique of **Official Notice** because it is a quick and easy way of providing confirmation of the completion of transactions.

#### **As per claim 41 & 42**

With regard to the limitation of *sending the transaction request identification to the registered user comprises sending the transaction request identification to a portable storage device held by the user and sending the transaction request identification from the portable storage device to the recipient*. Ice in column 3, lines 22-31 discloses “This apparatus includes a personal computer terminal, generally indicated as 10, which is connected by conventional means to a public network 12, such as the Internet, operating over a public switched telephone network. The personal computer terminal 10 includes a personal computer 14, a keyboard 16, a display unit 18, all of which may be conventional devices. The personal computer 14 includes a processor 20 and a storage device 22, which is used to store data and to store instructions forming a program executing in the processor 20.” Column 3, lines 36-41 discloses “The personal computer terminal 10 is also particularly configured to facilitate the generation and transmission of encrypted information, facilitating the use of the terminal 10 to purchase products and services and to direct bank transactions over the public network 12, while consistently maintaining a high level of security.” Ice does not explicitly disclose *a portable storage device*. However, the Examiner takes **Official Notice** that it is old and well known in the arts that personal computers are also portable storage devices.

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice & Robinson with the technique of **Official Notice** because it is a quick and easy way of providing confirmation of the completion of transactions.

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**As per claim 83**

With regard to the limitation of *sending a plurality of transaction request identifications to a user's electronic device in one transfer*; Ice in column 2, lines 24-30 discloses "The data base stores first and second data structures. The first data structure includes a first plurality of single-use credit card numbers, a serial number of an encryption unit associated with each single-use credit card number in the first plurality of single-use credit card numbers and found by locating the single-use credit card number in the plurality of single-use credit card number." Ice does not explicitly disclose sending to an electronic device in one transfer. However, the Examiner takes **Official Notice** that it is old and well known in the banking arts to provide a plurality of transaction numbers to a user for one-time use.

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice & Robinson with the technique of **Official Notice** because it is an easy and convenient way to send transaction requests to the user.

**As per claim 91**

With regard to the limitation of *wherein the generated single use transaction request identifier is only sent to the registered user once the registered user is identified to the satisfaction of the transaction manager apparatus, wherein identifying the registered user occurs when a remotely located electronic device of the registered user connects to the transaction manager apparatus*. Ice in column 5, line 50-53 discloses "When a match is found, the payment server reads the serial number associated with the single-use credit card number in the data structure 50, and searches the data structure 48 for this serial number" & column 5, lines 57-60 discloses "this decoded data is returned to the gateway server 58 which provided the single-use credit card number, providing the actual number of the credit card 28 in a conventional format." Ice does not explicitly disclose *identifying the registered user occurs when a remotely located electronic device of the registered user connects to the transaction manager apparatus*. However, the Examiner takes **Official Notice** that it is old and well known in the banking arts for a terminal to ask for a user verification ID before the user is able to access the terminal.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice & Robinson with the technique of **Official Notice** because it is an easy and convenient way to prevent fraud.

20. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ice in view of Robinson and in further view of Lapsley et al. US 2001/0000535.

**As per claim 13**

Ice discloses the limitations as shown in the rejection of Claim 1 above. Ice does not disclose the limitation of *the transaction manager apparatus confirming the bank information with the user's financial institution before creation of the transaction manager user account*. However, Lapsley, in claim 157 discloses "In one embodiment, the DPC validates the financial account data submitted during registration. This involves making certain that the financial account being registered is a valid account."

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ice & Robinson with the technique of Lapsley because it is an easy and convenient way to eliminate errors in transactions when using the system.

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### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **KITO R. ROBINSON** whose telephone number is **(571) 270-3921**. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Charles Kyle** can be reached on **(571) 272-6746**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kito R Robinson/  
Examiner, Art Unit 3695

28 October 2010

/Charles R. Kyle/  
Supervisory Patent Examiner, Art Unit 3695